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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,174	01/09/2004	Lilip Lau	PARCR 66327	8468
24201	7590	03/09/2005	EXAMINER	
FULWIDER PATTON LEE & UTECHT, LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE TENTH FLOOR LOS ANGELES, CA 90045			VENIAMINOV, NIKITA R	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/754,174	<b>Applicant(s)</b> LAU ET AL.	
	<b>Examiner</b> Nikita R Veniaminov	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/16/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) submitted on 08/16/2004 were considered by the examiner except two articles from NON-PATENT LITERATURE DOCUMENTS, which are undated, and US Patent Applications.

### *Claim Objections*

2. Claim 51 is objected to because of the following informalities: The claim should end with a period. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 38-43, 45-55 and 61-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardle (US 6,432,039) in view of Johnson (US 3,855,715). Wardle ('039) teaches a cardiac harness (10) configured to fit about a patient's heart, comprising:  
(claims 38 and 47) a plurality of individual modules [Figure 1 (12 and 24)]  
assembled together to form the harness (10) including a coupling (16) having a

first member (Figure 1, slit 14 on the left module) for selectively engaging a second member (Figure 1, slit 14 on the right module);

(claims 39 and 49) wherein one of the modules (24) is more compliant than another of the modules (12) (column 4, lines 66-67);

(claim 40) wherein at least two adjacent modules (12) are selectively releasable from another;

(claim 41) wherein at least two adjacent modules (12 and 24) are connected to each other;

(claim 43) wherein at least one pair of adjacent modules (12 and 24) are permanently affixed to one another;

(claims 42, 45, 46, 50, 51 61 and 62) wherein the modules are configured for minimally invasive delivery; wherein the modules are configured for in vivo or ex vivo assembly (Examiner states, that the phrase "configured for" states, that the device is capable for minimally invasive delivery, or in vivo assembly, thus does not provide any structural limitations of said device). Also, Wardle ('039) teaches both a lace (18) coupling of modules and a VELCRO hook and loop coupling of modules (column 4, lines 16-36).

However, Wardle ('039) does not teach a cardiac harness, which includes a zip coupling having a first member for selectively engaging a second member.

Johnson ('715) teaches a replaceable zipper unit with holes so that the device may be fastened by laces through the holes (Figure 1 and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the lace or VELCRO coupling of Wardle ('039) with the zip coupling of Johnson ('715) to provide quick coupling of adjacent modules as taught by Johnson ('715), and as no criticality was asserted in using a zip coupling as opposed to other coupling.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 38-55 and 61-63** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-3, 5-9, 11-14, 16-18, 20 and 21** of U.S. Patent No. 6,723,041 B2 in view of Johnson (US 3,855,715). Claims of the Patent ('041) disclose at least two adjacent modules selectively releaseable from each other, but they do not disclose a zip coupling having a first member for selectively engaging a second member.

Johnson ('715) teaches a replaceable zipper unit with holes so that the device may be fastened by laces through the holes (Figure 1 and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the coupling of the Patent ('041) with the zip coupling of Johnson ('715) to provide quick coupling of adjacent modules, as taught by Johnson ('715), and as no criticality was asserted in using a zip coupling as opposed to other coupling.

It would have been obvious to one of ordinary skill in the art at the time of the invention first to engage the zipper teeth of the coupling member of Johnson ('715) on the harness of the Patent in vivo after engaging them ex vivo in order to provide an accurate fit of the harness on the patient's heart.

6. Claims **38, 40-42, 44-48, 50-64** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **38, 42, 44-60 and 62-64** of copending Application No. 10/754,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the present application are broader than claims in the copending Application. Therefore, any apparatus or method meeting the limitations of the copending Application would necessarily meet those of the claims of the present Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

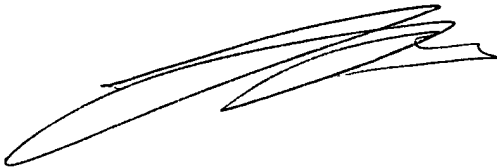
***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Igl et al. ('910) and Vartanian ('706).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikita R Veniaminov whose telephone number is (571) 272-4735. The examiner can normally be reached on Monday-Friday 8 A.M.-5 P.M..

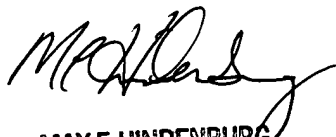
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



February 23, 2005.

Nikita R Veniaminov  
Examiner  
Art Unit 3736



MAX F. HINDENBURG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700